

## **REMARKS**

By this Amendment, Applicants amend claims 1, 4, 10, 16, 20, 27, 42, and 46. Claims 1-6, 8-31, and 42-46 remain pending in this application.

In the Office Action,<sup>1</sup> the Examiner rejected claims 1, 4, 10, 16, 20, 27, 42, and 46 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; rejected claims 1, 4, 10, 16, 20, 27, 42, and 46 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 1-6, 9-12, 15, 16, 18-20, 22, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Byrd (U.S. Patent No. 6,081,899) in view of Rubin (U.S. Patent No. 5,638,446), and in further view of Cook (U.S. Patent No. 6,675,153); rejected claims 13, 14, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Byrd in view of Rubin and Cook, and in further view of "X.509"; and rejected claims 27-31 and 42-46 under 35 U.S.C. § 103(a) as being unpatentable over Byrd in view of Rubin and Cook, and in further view of Murray (U.S. Patent No. 6,321,333).

### **I. REJECTION UNDER § 112, ¶1**

Although Applicants respectfully traverse the rejection of claims 1, 4, 10, 16, 20, 27, 42, and 46 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, Applicants have amended the claims to delete the

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

terms “sender account number” and “a payment.” Accordingly, Applicants request that the Examiner withdraw the rejection under 35 U.S.C. § 112, first paragraph.

## **II. REJECTION UNDER § 112, ¶2**

Although Applicants respectfully traverse the rejection of claims 1, 4, 10, 16, 20, 27, 42, and 46 under 35 U.S.C. § 112, second paragraph, as being indefinite, as noted above, Applicants have amended the claims to delete the term “a payment.” Accordingly, Applicants request that the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

## **III. REJECTION OF CLAIMS 1-6, 9-12, 15, 16, 18-20, 22, 25, AND 26 UNDER**

### **§ 103(a)**

Applicants respectfully traverse the rejection of claims 1-6, 9-12, 15, 16, 18-20, 22, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Byrd (U.S. Patent No. 6,081,899) in view of Rubin (U.S. Patent No. 5,638,446), and in further view of Cook (U.S. Patent No. 6,675,153) because a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a

manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001).

Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8<sup>th</sup> ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001). Here, a *prima facie* case of obviousness has not been established for at least the reason that the applied references fail to teach each and every element of the claims.

Claim 1, as amended, recites a method for authenticating an electronic message containing message data and an electronic address including, among other steps, "sending the digest, the temporal stamp, and the digital signature to the electronic address as an electronic postmark, wherein the electronic postmark includes a value that uniquely identifies the electronic postmark." The applied references, whether taken alone or in combination, do not disclose or suggest at least this element of claim 1.

In the Office Action, the Examiner contends Byrd discloses a client creating a message, sending the message to be authenticated by a server appending a timestamp and a digital signature, and forwarding the message to a recipient that authenticates the stamp and signature. See page 3. The Examiner also admits that Byrd "does not teach creating a digest," "a log," or "sending an account number and attaching the payment to a digest." See id. Even to the extent that the Examiner's characterization of Byrd is correct, Byrd does not teach or suggest the claimed "electronic postmark." That is, Byrd does not teach or suggest an "electronic postmark [that] includes a value that uniquely identifies the electronic postmark," as required by claim 1.

Rubin does not compensate for the above deficiency of Byrd. In particular, with respect to Rubin, the Examiner contends that the reference discloses a user creating a

digest and sending an electronic file to a third party for authentication that digitally signs the hash in the creation of a certificate. See Office Action at page 4. Even to the extent that the Examiner's characterization of Rubin is correct, Rubin does not teach or suggest an "electronic postmark [that] includes a value that uniquely identifies the electronic postmark," as required by claim 1.

Further, Cook does not compensate for the above deficiencies of Byrd and Rubin. The Examiner contends that Cook teaches a transaction system where the account number is sent with a message and appending a time stamp and payment to a digest. See Office Action at page 4. Even if the Examiner's characterization of Cook is correct, Cook's "account number" for an account with a merchant does not constitute or suggest the claimed "electronic postmark [that] includes a value that uniquely identifies the electronic postmark," as required by claim 1. Accordingly, Cook does not remedy the deficiencies of Byrd and Rubin for at least this reason. Since Byrd, Rubin, and Cook, whether taken individually or in combination, fail to teach or suggest all of the elements of claim 1, a *prima facie* case of obviousness has not been established. Therefore, the Examiner should withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Independent claims 10, 16, and 20, while of a different scope from each other and claim 1, have been amended to include recitations similar to those of claim 1. Accordingly, for reasons similar to those discussed above, Byrd, Rubin, and Cook, individually or in combination, fail to teach or suggest all of the elements of claims 10, 16, and 20. Accordingly, a *prima facie* case of obviousness has not been established

with respect to claims 10, 16, and 20, and the Examiner should withdraw the § 103(a) rejection of these claims.

Dependent claims 2-6, 9, 11, 12, 15, 18-19, 22, 25, and 26, depend from one of independent claims 1, 10, 16, and 20. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 2-6, 9, 11, 12, 15, 18-19, 22, 25, and 26 at least due to their dependencies. Therefore, the Examiner should withdraw the rejection of these claims under 35 U.S.C. § 103(a) as well.

#### **IV. REJECTION OF CLAIMS 13, 14, 23, AND 24 UNDER §103(a)**

Applicants respectfully traverse the rejection of claims 13, 14, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Byrd in view of Rubin and Cook, and in further view of “X.509.” A *prima facie* case of obviousness has not been established with respect to these claims at least due to their dependency from one of independent claims 10 and 20.

For example, independent claim 10 requires “generating an electronic postmark data structure ... [that includes] a value that uniquely identifies the electronic postmark.” Independent claim 20 requires “sending ... an electronic postmark ... [that] includes a value that uniquely identifies the electronic postmark, to the authentication server.” As discussed above, Byrd, Rubin, and Cook, individually or in combination, fail to teach or suggest these elements.

Moreover, the Examiner cited “X.509,” alleging the reference teaches a “certificate [containing] the subject’s public key.” See Office Action at page 5. Even assuming the Examiner’s characterization of “X.509” is correct, “X.509” does not

compensate for the deficiencies of Byrd, Rubin, and Cook. That is, “X.509” does not teach or suggest “generating an electronic postmark data structure ... [that includes] a value that uniquely identifies the electronic postmark” or “sending ... an electronic postmark ... [that] includes a value that uniquely identifies the electronic postmark, to the authentication server,” as required by independent claims 10 and 20, respectively. Accordingly, dependent claims 13, 14, 23, and 24 are allowable at least due to their dependency from one of independent claims 10 and 20, and the Examiner should withdraw the rejection of these claims under 35 U.S.C. § 103(a).

#### **V. REJECTION OF CLAIMS 27-31 AND 42-46 UNDER § 103(a)**

Applicants respectfully traverse the rejection of claims 27-31 and 42-46 under 35 U.S.C. § 103(a) as being unpatentable over Byrd in view of Rubin and Cook and in further view of Murray (U.S. Patent No. 6,321,333) because a *prima facie* case of obviousness has not been established.

Independent claim 27, as amended, recites a method for authenticating an electronic message including, among other steps, “generating an electronic postmark for the hash value by the authentication server, the electronic postmark including time and date information and a value that uniquely identifies the electronic postmark.” The applied references, whether taken alone or in combination, do not disclose or suggest at least this element of claim 27.

As discussed above, Byrd, Rubin, and Cook, individually or in combination, fail to teach or suggest an “electronic postmark including ... a value that uniquely identifies the electronic postmark,” as required by claim 27. Moreover, Murray does not teach at

least this element. In particular, the Examiner cited Murray, alleging the reference teaches “getting a digital public key authorized by a certificate authority.” See Office Action at page 7. Even assuming the Examiner’s characterization of Murray is correct, Murray does not teach or suggest an “electronic postmark including ... a value that uniquely identifies the electronic postmark,” as required by claim 27. Accordingly, Murray does not remedy the deficiencies of Byrd, Rubin, and Cook. Since Byrd, Rubin, Cook, and Murray, whether taken individually or in combination, fail to teach or suggest all of the elements of claim 27, a *prima facie* case of obviousness has not been established. Therefore, the Examiner should withdraw the rejection of claim 27 under 35 U.S.C. § 103(a).

Independent claims 42 and 46, while of a different scope from each other and claim 27, have been amended to include recitations similar to those of claim 27. Accordingly, for reasons similar to those discussed above, Byrd, Rubin, Cook, and Murray, individually or in combination, fail to teach or suggest all of the elements of claims 42 and 46. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 42 and 46, and the Examiner should withdraw the § 103(a) rejection of these claims.

Dependent claims 28-31 and 43-45 depend from one of independent claims 27 and 42. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 28-31 and 43-45 at least due to their dependencies. Therefore, the Examiner should also withdraw the rejection of claims 28-31 and 43-45 under 35 U.S.C. § 103(a).

**CONCLUSION**

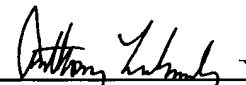
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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